

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CECIL R. GURGANUS,  
RAY C. SANFORD  
and  
FRANCIS L. HORNING

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Appeal No. 95-1100  
Application 07/928,071<sup>1</sup>

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ON BRIEF

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Before JOHN D. SMITH, WEIFFENBACH and PAK, Administrative  
Patent Judges.

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<sup>1</sup> Application for patent filed August 12, 1992. According to appellants, the application is a continuation of Application 07/559,125, filed July 26, 1990, abandoned.

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JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 21 through 33. Claims 19 and 20 stand withdrawn from further consideration as directed to a non-elected invention.

Claim 21 is representative and is reproduced below:

21. A gasketing compound exhibiting low plasticizer migration and low marring effect on painted surfaces comprising:

- (a) a first vinyl chloride resin having an inherent viscosity greater than about 1.02, a porosity greater than about .34 cc/gm and having a high gel content;
- (b) a second vinyl chloride resin having an inherent viscosity of at least about 1.02, a porosity of at least about .34 cc/gm and having a low gel content, or no gel content, the inherent viscosity differing from the inherent viscosity of said first vinyl chloride resin; and
- (c) from an effective amount up to about 80 parts per 100 parts of resin of an external plasticizer.

The reference of record relied upon by the examiner is:

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Matsumoto et al. (Matsumoto)<sup>2</sup>      5,137,960      Aug. 11,  
1992

The appealed claims stand rejected for obviousness  
(35 U.S.C. § 103) in view of Matsumoto.

We reverse.

The subject matter on appeal is directed to a gasketing compound (composition) comprising a first vinyl chloride resin, a second vinyl chloride resin, and an external plasticizer. The first vinyl chloride resin has a high gel content, and an inherent viscosity greater than about 1.02, and a porosity greater than about .34 cc/gm. The second vinyl chloride resin has a low gel content, an inherent viscosity of at least about 1.02, and a porosity of at least about .34 cc/gm. When the composition is molded into a gasket, the molded article exhibits low plasticizer migration and a low marring effect on a painted surface.

Like the claimed invention, Matsumoto discloses a composition comprising a first vinyl chloride polymer, a

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<sup>2</sup> The Matsumoto patent matured from Application 07/702,158, filed May 15, 1991, which was a continuation of Application 07/361,568, filed June 5, 1989.

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second vinyl chloride polymer and a plasticizer. Specifically, see the reference at column 1, line 61, through column 2, line 10. There is no express disclosure in Matsumoto, however, regarding the properties of gel content, inherent viscosity, and porosity for the vinyl chloride resins described. In the Answer, the examiner argues that Matsumoto's first vinyl chloride resin described at column 2, line 47, through column 3, line 60, has a high gel content while Matsumoto's second vinyl chloride resin disclosed at column 4, lines 40 through 52, has a low or no gel content, and appellants have not challenged the examiner's factual determinations with respect to the gel content of these prior art polyvinyl chloride materials.

Implicitly acknowledging that Matsumoto contains no express disclosure of the properties of inherent viscosity and porosity for the described vinyl chloride resins, the examiner contends that it is proper to shift the burden to the appellants "when the Examiner cannot determine whether or not the reference product inherently possesses the properties which render obvious the claimed product but has a basis for

shifting the burden of proof to appellants." See the Answer at page 4.

Where there is adequate "reason to believe" that a functional limitation or property asserted to be critical for establishing novelty in claimed subject matter may, in fact, be an inherent characteristic of the prior art, the Patent and Trademark Office possesses the authority to require an applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 597 (CCPA 1980); In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971). Here, there is an inadequate factual basis supporting a "reason to believe" that the specific parameters claimed, i.e., the inherent viscosity and the porosity are inherent characteristics of the prior art resins. That the prior art resin composition may include a polyvinyl chloride having high gel content combined with another polyvinyl chloride with no gel content provides no basis or "reason to believe" that the high gel content vinyl chloride resin has an inherent viscosity and porosity as claimed while at the same time the

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low gel content vinyl chloride resin also has an inherent viscosity and porosity as claimed. There is simply no factual support in the record that relates gel content to either the parameter of inherent viscosity or porosity. Accordingly, the examiner's rejection of the appealed claims is reversed.

As a final matter, we observe that appellant's brief at page 3 states that there are two issues for review on appeal, and the first issue is whether or not the originally-filed application provides adequate support for the invention as now claimed. In the Answer at page 1, the examiner acknowledged that appellants' statement of the issues in the Brief is correct. However, the Examiner's Answer does not contain a statement of rejection of the appealed claims under 35 U.S.C. § 112, first paragraph. Accordingly, this application is remanded to the examiner to clarify whether or not the rejection of the appealed claims under 35 U.S.C. § 112, first paragraph, has been withdrawn. If the examiner is no longer adhering to this rejection, the examiner should point out where in the originally-filed application, adequate written description is present to support the concept of

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admixing a high gel content first vinyl chloride resin having the claimed inherent viscosity and porosity parameters with a low gel content second vinyl chloride resin having the claimed inherent viscosity and porosity parameters.

In summary, the examiner's rejection of the appealed claims under 35 U.S.C. § 103 is reversed. The application is remanded to the examiner to clarify the record regarding the 35 U.S.C. § 112, first paragraph, issues.

This application, by virtue of its "special" status, requires an immediate action, MPEP § 708.01(d). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REVERSED AND REMANDED

	JOHN D. SMITH	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	BOARD OF
PATENT		)	
	CAMERON WEIFFENBACH	)	APPEALS AND
	Administrative Patent Judge	)	
INTERFERENCES		)	
		)	

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CHUNG K. PAK )  
Administrative Patent Judge )

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